UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/580,305	05/26/2000	Anthony A. Shah-Nazaroff	042390.P6484D2	9133

7590 05/21/2004

Gordon R Lindeen III
Blakely Sokoloff Taylor & Zafman LLP
7th Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025

EXAMINER	
MA, JOHNNY	

ART UNIT	PAPER NUMBER
2614	3

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/580,305	SHAH-NAZAROFF ET AL.	
	Examiner	Art Unit	
	Johnny Ma	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 February 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 2.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 7, 17, and 22 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 11, and 16 of prior U.S. Patent No. 6,157,377. This is a double patenting rejection.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-6, 8, 14-16, 18, 21, 23, and 25-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 11-12, 14, 16, and 17 of U.S. Patent No. 6,157,377. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claim 1 of the instant application is encompassed by patented claim 1. The claimed "receiving a selection to buy an upgraded media feature for a programming transmission" (line 2) equates to that of patented claim "receiving a selection to buy an upgraded media feature for a programming transmission" (lines 2-3). The claimed "automatically coordinating purchase of the upgraded media feature for the programming transmission" equates to that of patented claim "automatically coordinating purchase of the upgraded media feature for the programming transmission" (lines 4-5). The claimed "and automatically coordinating provision of the upgraded media feature for the programming transmission" (lines 5-6) equates to that of patented claim "and automatically coordinating provision of the upgraded media feature for the programming transmission" (lines 5-7). Allowance of claim 1 of instant application would result in an unjustified time-wise extension of the monopoly defined by patent claim 1.

Claim 2 of the instant application is encompassed by patented claim 2. The claimed "wherein the receiving comprises receiving the selection from an entertainment system" (lines 1-2) equates to that of patented claim "wherein the receiving comprises receiving the selection from an entertainment system" (lines 1-2). The claimed "and the programming transmission is provided to the entertainment system with the upgraded media feature" (lines 2-3) equates to that of patented claim 2 "and the programming transmission is provided to the entertainment system with the upgraded system" (lines 2-4).). Allowance of claim 2 of instant application would result in an unjustified time-wise extension of the monopoly defined by patent claim 2.

Claim 3 of the instant application is encompassed by patented claim 3. The claimed "billing a client for services performed by a server system" (line 3) equates to patented claim "billing a client for services performed by the server system" (lines 4-5) the claims are similar

but for a minor variation in wording not affecting the scope, i.e. "a server system" as opposed to "the server system." The claimed "and providing billing information about the client to at least one of a plurality of programming transmission sources that provided the programming transmission" (lines 3-5) equates to patented claim "and providing billing information about the client to at least one of a plurality of programming transmission sources that provided the programming transmission" (lines 5-8).). Allowance of claim 3 of instant application would result in an unjustified time-wise extension of the monopoly defined by patent claim 3.

Claim 4 of the instant application is encompassed by patented claim 4. The claimed "wherein the billing is one of performed individually for each billable transaction" (lines 1-2) equates to patented claim "wherein the billing is one of performed individually for each billable transaction" (lines 1-2). The claimed "and performed according to a billing cycle for at least one billable transaction during the billing cycle to" (lines 2-3) equates to patented claim "and performed according to a billing cycle for at least one billable transaction during the billing cycle" (lines 2-4).). Allowance of claim 4 of instant application would result in an unjustified time-wise extension of the monopoly defined by patent claim 4.

Claim 5 of the instant application is encompassed by patented claim 5. The claimed "billing a client for services performed by a server system and at least one of a plurality of programming transmission sources that provided the programming transmission" (lines 3-4) equates to patented claim "billing a client for services performed by the server system and at least on of a plurality of programming transmission sources that provided the programming transmission" (lines 4-7) the claims are similar but for a minor variation wording not affecting scope, i.e. "a server system" as opposed to "the server system." The claimed "receiving a bill for

the portion of the services performed by the at least one of the plurality of programming transmission sources at a later time" (lines 5-6) equates to patented claim "receiving a bill for the portion of the services performed by the at least one of the plurality of programming transmission sources at a later time" (lines 8-10).). Allowance of claim 5 of instant application would result in an unjustified time-wise extension of the monopoly defined by patent claim 5.

Claim 6 of the instant application is encompassed by patented claim 6. The claimed "wherein the billing the client and receiving the bill are one of performed individually for each billable transaction" (lines 1-2) equates to patented claim "wherein the billing the client and receiving the bill are one of performed individually for each billable transaction" (lines 1-3). The claimed "and performed according to a billing cycle for at least one transaction during the billing cycle" (lines 2-3) equates to patented claim "and performed according to a billing cycle for at least one transaction during the billing cycle" (lines 3-4).). Allowance of claim 6 of instant application would result in an unjustified time-wise extension of the monopoly defined by patent claim 6.

Claim 8 of the instant application is encompassed by patented claim 26. The claimed "sending a selection to a server system to buy an upgraded media feature for a programming transmission" (lines 2-3) equates to patented claim "sending a selection to a server system to buy an upgraded media feature for a programming transmission" (lines 4-6). The claimed "and receiving the programming transmission with the upgraded media feature" (lines 3-4) equates to patented claim "receive the programming transmission" (lines 7-8) and "automatically coordinate provision of the upgraded media feature for the programming transmission" (lines 25-

27).). Allowance of claim 8 of instant application would result in an unjustified time-wise extension of the monopoly defined by patent claim 26.

Claim 14 of the instant application is encompassed by patented claim 11. The claimed "receiving a selection to buy an upgraded media feature for a programming transmission" (line 3) equates to patented claim "receiving a selection to buy an upgraded media feature for a programming transmission" (lines 5-6). The claimed "automatically coordinating purchase of the upgraded media feature for the programming transmission" (lines 4-5) equates to that of patented claim "automatically coordinating purchase of the upgraded media feature for the programming transmission" (lines 7-8). The claimed "and automatically coordinating provision of the upgraded media feature for the programming transmission" (lines 5-7) equates to that of patented claim "and automatically coordinating provision of the upgraded media feature for the programming transmission" (lines 8-10).). Allowance of claim 14 of instant application would result in an unjustified time-wise extension of the monopoly defined by patent claim 11.

Claim 15 of the instant application is encompassed by patented claim 12. The claimed "billing a client for services performed by a server system" (line 3) equates to that of claim "billing a client for services performed by the server and system" (lines 4-5) the claims are similar but for a minor variation in wording not affecting the scope, i.e. "a server system" as opposed to "the server system." The claimed "and providing billing information about the client to at least one of a plurality of programming transmission sources that provided the programming transmission" (lines 3-5) equates to that of patented claim "and providing billing information about the client to at least one of a plurality of programming transmission sources that provided

the programming transmission" (lines 5-8).). Allowance of claim 15 of instant application would result in an unjustified time-wise extension of the monopoly defined by patent claim 12.

Claim 16 of the instant application is encompassed by patented claim 14. The claimed "billing a client for services performed by a server system" (line 3) equates to that of patented claim "billing a client for services performed by the server system "(lines 4-5) the claims are similar but for a minor variation in wording not affecting the scope, i.e. "a server system" as opposed to "the server system." The claimed "and at least one of a plurality of programming transmission sources that provided the programming transmission" (lines 3-4) equates to that of patented claim "and at least one of a plurality of programming transmission sources that provided the programming transmission" (lines 5-7). The claimed "and receiving a bill for the portion of the services performed by the at least one of the plurality of programming transmission sources at a later time" (lines 4-6) equates to that of patented claim "and receiving a bill for the portion of the services performed by the at least one of the plurality of programming transmission sources at a later time" (lines 7-10).). Allowance of claim 16 of instant application would result in an unjustified time-wise extension of the monopoly defined by patent claim 14.

Claim 18 of the instant application is encompassed by patented claim 18. The claimed "sending a selection to a server system to buy an upgraded media feature for a programming transmission" (lines 3-4) equates to patented claim "sending unit for sending a selection to a server system to buy an upgraded media feature for a programming transmission" (lines 4-6). The claimed "and receiving the programming transmission with the upgraded media feature" (line 5) equates to patented claim "receive the programming transmission" (lines 7-8) and

"automatically coordinate provision of the upgraded media feature for the programming transmission" (lines 25-27). Note that although claim 18 of the instant application is directed to machine readable instructions and patented claim 26 is directed to a system, this is not considered to be patentable distinct. It is notoriously well known in the art to perform functions in such computer systems using software that is inherently in the form of machine readable instructions.). Allowance of claim 18 of instant application would result in an unjustified time-wise extension of the monopoly defined by patent claim 18.

Claim 21 of the instant application is encompassed by patented claim 16. The claimed "a server system to receive a selection to buy an upgraded media feature for a programming transmission" (lines 2-3) equates to that of patented claim "a server system to receive a selection to buy an upgraded media feature for a programming transmission" (lines 2-3). The claimed "automatically coordinate purchase of the upgraded media feature for the programming transmission" (lines 3-4) equates to that of patented claim "automatically coordinate purchase of the upgraded media feature for the programming transmission" (lines 3-5). The claimed

"and automatically coordinate provision of the upgraded media feature for the programming transmission" (lines 4-5) equates to that of patented claim "and automatically coordinate provision of the upgraded media feature for the programming transmission" (lines 5-7).). Allowance of claim 21 of instant application would result in an unjustified time-wise extension of the monopoly defined by patent claim 16.

Claim 23 of the instant application is encompassed by patented claim 26. The claimed "client system" (line 2) equates to patented claim "client system" (line 3). The claimed "to send a selection to a server system to buy an upgraded media feature for a programming

transmission" (lines 2-3) equates to patented claim "sending a selection to a server system to buy an upgraded media feature for a programming transmission" (lines 4-6). The claimed "said client system to receive the programming with the upgraded media feature" equates to patented claim "[client system] receiving unit to receive the programming transmission" (lines 7-8) and "a provision unit to automatically coordinate provision of the upgraded media feature for the programming transmission" (lines 25-27).). Allowance of claim 23 of instant application would result in an unjustified time-wise extension of the monopoly defined by patent claim 26.

Claim 25 of the instant application is encompassed by patented claim 17. The claimed "a receiver to receive a selection to buy an upgraded media feature for a programming transmission" (lines 2-3) equates to and encompassed by that of patented claim "a receiver to receive a selection from a client system to buy an upgraded media feature for a programming transmission" (lines 2-4). The claimed "a purchasing unit to automatically coordinate purchase of the upgraded media feature for the programming transmission" (lines 4-5) equates to that of patented claim "a purchasing unit to automatically coordinate purchase of the upgraded media feature for the programming transmission" (lines 5-7). The claimed "and a provision unit to automatically coordinate provision of the upgraded media feature for the programming transmission" (lines 5-7) equates to that of patented claim "and a provision unit to automatically coordinate provision of the upgraded media feature for the programming transmission" (lines 16-19).). Allowance of claim 25 of instant application would result in an unjustified time-wise extension of the monopoly defined by patent claim 17.

Claim 26 of the instant application is encompassed by patented claim 26. The claimed

"a sending unit to send a selection to a server system to buy an upgraded media feature for a programming transmission" (lines 2-3) equates to that of patented claim "a sending unit for sending a selection to a server system to by an upgraded media feature for a programming transmission" (lines 4-6). The claimed "a receiving unit to receive the programming transmission" (line 4) equates to that of patented claim " a receiving unit to receive the programming transmission (lines 7-8).). Allowance of claim 26 of instant application would result in an unjustified time-wise extension of the monopoly defined by patent claim 26.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 8, 11-15, 18, 21, 23, 25, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Carrubba et al. (US 5,629,866).

As to claim 1, note the Carrubba et al. reference that discloses an audio-visual presentation system. The claimed "receiving a selection to buy an upgraded media feature for a programming transmission" is met by "...a system as defined in the opening paragraph is characterized in that the complementary part is intended for enhancing the quality of the audio-visual presentation that can be achieved with the basic part. In this manner the user has the possibility of enhancing the quality of the audio-visual presentation, such as a video film. The user is first offered by a service provider a basic part of a audio-visual presentation with a lower quality, such as a presentation with a low picture resolution, free of charge or at a reduced rate

and may then decide whether he wishes to have the complementary party and thus a more complete version of the audio-visual presentation by paying a considerably higher rate (Carrubba et al. 1:52-64) wherein the system services such requests (Carrubba et al. 4:35-49). The claimed "automatically coordinating provision of the upgraded media feature for the programming transmission" is met by "[w]ith the video-on-demand service, video film data are supplied to CD-I players on request. The databank may be controlled by a provider who provides the basic part free of charge or at a small amount on CD-I disc to the users, and allows users to read the second part from the databank against payment of a higher amount" (Carrubba et al. 4:38-42). The claimed "automatically coordinating provision of upgrade media feature for the programming transmission" is met by "[a]n embodiment for a system according to the invention is characterized in that the storage medium containing the basic part is located near the merging means and in that the other storage medium containing the complementary part is linked to the merging means via a transmission line of a communications network. The communications network is, for example, the public telephone network. The storage medium containing the complementary part is located, for example, in a data bank controlled by the provider. The complementary part stored in the databank is accessible to a plurality of users of a system according to the invention via the telephone network" (Carrubba et al. 1:65-67; 2:1-9) wherein CPU controls the transmission of the media upgrade feature (Carrubba et al. 4:21-32).

As to claim 2, the claimed "wherein the receiving comprises receiving the selection from an entertainment system, and the programming transmission is provided to the entertainment system with the upgraded media feature" is met by the entertainment system of figure 1 and the

programming transmission (via the telephone network) which is provided to the entertainment system.

As to claim 8, the claimed "sending a selection of a server system to buy an upgraded media feature for a programming transmission" is met by "...a system as defined in the opening paragraph is characterized in that the complementary part is intended for enhancing the quality of the audio-visual presentation that can be achieved with the basic part. In this manner the user has the possibility of enhancing the quality of the audio-visual presentation, such as a video film. The user is first offered by a service provider a basic part of a audio-visual presentation with a lower quality, such as a presentation with a low picture resolution, free of charge or at a reduced rate and may then decide whether he wishes to have the complementary party and thus a more complete version of the audio-visual presentation by paying a considerably higher rate (Carrubba et al. 1:52-64) wherein the system services such requests (Carrubba et al. 4:35-49). The claimed "automatically coordinating provision of the upgraded media feature for the programming transmission" is met by "[w]ith the video-on-demand service, video film data are supplied to CD-I players on request. The databank may be controlled by a provider who provides the basic part free of charge or at a small amount on CD-I disc to the users, and allows users to read the second part from the databank against payment of a higher amount" (Carrubba et al. 4:38-42). The claimed "receiving a programming transmission with the upgraded media feature" is met by "[a]n embodiment for a system according to the invention is characterized in that the storage medium containing the basic part is located near the merging means and in that the other storage medium containing the complementary part is linked to the merging means via a transmission line of a communications network. The communications network is, for example, the public

telephone network. The storage medium containing the complementary part is located, for example, in a data bank controlled by the provider. The complementary part stored in the databank is accessible to a plurality of users of a system according to the invention via the telephone network" (Carrubba et al. 1:65-67; 2:1-9) wherein CPU controls the transmission of the media upgrade feature (Carrubba et al. 4:21-32).

As to claim 11, the claimed "wherein the programming transmission comprises at least one of a movie, a documentary, an audio production, an interactive media event, a situation comedy, a news program, and a televised sport event" is met by audio-visual programming discussed throughout the reference including but not limited to column 1, lines 49-64.

As to claim 12, the claimed "wherein the upgraded media feature comprises at least one of a video upgrade, an audio upgrade, a recordable version, and an increased access rate for a interactive event" is met by higher resolution audio-visual programming discussed throughout the reference including by not limited to column 1, lines 59-64 and column 2, lines 28-31.

As to claim 13, the claimed "wherein the programming transmission is received from one of a plurality of programming transmission sources and the plurality of programming transmission sources include at least one of cable television, antenna reception, satellite reception, mini-dish satellite reception, telephone dial-up service, and Internet access" is met by the telephone network programming transmission source as discussed throughout the reference including but not limited to column 2, lines 3-9.

The limitations set forth in apparatus claims 14 and 15 correspond to the limitations in method claims 1 and 2 respectively.

The limitations set forth in apparatus claims 18, 23 and 26 correspond to the limitations in method 8.

The limitations set forth in apparatus claim 21 and 25 correspond to the limitations of method 1.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 3-6, 9-10, 16, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carrubba et al. (US 5,629,866).

As to claims 3, 5, 9, 16, and 19, the Carrubba et al. reference discloses charging or billing the client for the upgraded media feature (Carrubba et al. 2:38-42). However, the Carrubba et al. reference does not specifically disclose providing the billing information about the client to at least one of a plurality of programming transmission sources, receiving a bill for the portion of the services performed and/or receiving a bill base don the upgraded media feature as recited in the claims. Nevertheless, the examiner gives Official Notice that it is well known in the art to provide billing information about the client to programming sources, receiving a bill for the portion of the services performed and/or receiving a bill based on the upgraded feature for the typical advantage of appropriately charging clients for services provided to them from the corresponding transmission sources. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the

Carrubba et al. system (if necessary) to include providing the billing information about the client to at least one of a plurality of programming transmission sources, receiving a bill for the portion of the services formed and/or receiving a bill based on the upgraded media feature because it is typical to charge clients for services provided to them from the corresponding transmission sources.

As to claims 4 and 6, note the Carrubba et al. reference discloses billing the client for the upgraded media. However, the Carrubba et al. reference does not specifically disclose billing is performed individually for each billing transaction and performed according to a billing cycle as recited in the claims. Nevertheless, the examiner gives Official Notice that it is well known in the art to bill individually for each transaction and to bill according to a billing cycle because these are typical accounting techniques utilized to show clients an itemized list of services rendered for a specified time period. For example: (1) cable television companies provide individual transactions (itemized list) for regular programming, pay-per-view programming, equipment charges, taxes etc. for a monthly period; and (2) telephone companies list transactions (itemized list) for local calls, long distance class, line charges, special feature charges and taxes for a monthly period. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Carrubba et al. system (if necessary) to include billing to be performed individually for each billing transaction and billing to be performed according to a billing cycle because there are typical accounting techniques utilized to show clients an itemized list of services rendered for a specified time period.

As to claims 10 and 20, note the Carrubba et al. reference discloses billing the client for upgraded media. However, the Carrubba et al. reference does not specifically disclose a charge to a credit account as recited in the claims. Nevertheless, the examiner gives Official Notice that it is well known in the art to receive a bill by charging a credit account at the end of a billing cycle because this is a common accounting/billing technique utilized to easily obtain payment from clients and for services rendered (i.e. the user does not have to mail payment). For example, America Online users, life insurance customers, car insurance customers, electric power users each have the ability to pay for services on a monthly basis by charges posted to their credit accounts. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Carrubba et al. system (if necessary) to include receiving a bill comprising a charge to a credit account because this is a common accounting/billing technique utilized to easily obtain payment form clients for services rendered (i.e. the user does not have to mail payment).

9. Claims 7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carrubba et al. (US 5,629,866) in further view of Maeng (US 6,476,873 B1).

As to claim 7, note the Carrubba et al. reference discloses providing purchasable enhancements to an audio-visual program wherein "[w]ith the video-on-demand service, video film data are supplied to CD-I players on request. The databank may be controlled by a provider who provides the basic part free of charge or at a small amount on CD-I disc to the users, and allows users to read the second part from the databank against payment of a higher amount. In other words, the Carrubba et al. reference discloses transmission of the basic part and enhanced part of the audio-visual transmission separately. However, the Carrubba et al. reference is silent

as to modifying the transmission of the programming transmission to the client system with the upgraded media feature. Now note, the Maeng reference that discloses the enhancement of a selectable region of video. The claimed "modifies transmission of the programming transmission to the client system with the upgraded media feature" is met by the Maeng user designation of the type of video information desired for display and designation of a portion of the display for enhancement wherein control information is sent to the sender which in turn provides the requested information (Maeng 6:40-67; 7:1-4) where the sender and receiver are coupled via a communications line (Maeng 4:55-67). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Carrubba et al. purchasable enhancements with the Maeng transmission of video and enhanced video over the same communication medium for the purpose of providing a basic part and enhanced part of an audio visual program over one transmission means instead of two separate transmission means for the purpose of facilitating the dissemination of such programming among remote locations. Also note, the Carrubba et al. reference discloses simultaneously supplying different data to a plurality of users (Carrubba et al. 4:33-37) and The Maeng reference discloses a sender transmitting video. However, the Carrubba et al. and Maeng combination does not specifically teach a plurality of programming transmission sources. Nevertheless, the examiner gives Official Notice that it is notoriously well known in the art to employ a plurality of programming transmission sources for the purpose of providing a plurality of programs to viewers in order to provide users with a number of choices to select from and to increase the likelihood that at least on program being offered will meet the users interest thus increasing viewer ship and business for the provider. Therefore, the examiner submits that it

would have been obvious to one of ordinary skill in the art to further modify the Carrubba et al. and Maeng combination accordingly for the above stated advantages.

As to claim 17, note the Carrubba et al. reference discloses providing purchasable enhancements to an audio-visual program wherein "[w]ith the video-on-demand service, video film data are supplied to CD-I players on request. The databank may be controlled by a provider who provides the basic part free of charge or at a small amount on CD-I disc to the users, and allows users to read the second part from the databank against payment of a higher amount. In other words, the Carrubba et al. reference discloses transmission of the basic part and enhanced part of the audio-visual transmission separately. However, the Carrubba et al. reference is silent as to modifying the transmission of the programming transmission to the client system with the upgraded media feature. Now note, the Maeng reference that discloses the enhancement of a selectable region of video. The claimed "modifies transmission of the programming transmission to the client system with the upgraded media feature" is met by the Maeng user designation of the type of video information desired for display and designation of a portion of the display for enhancement wherein control information is sent to the sender which in turn provides the requested information (Maeng 6:40-67; 7:1-4) where the sender and receiver are coupled via a communications line (Maeng 4:55-67). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Carrubba et al. purchasable enhancements with the Maeng transmission of video and enhanced video over the same communication medium for the purpose of providing a basic part and enhanced part of an audio visual program over one transmission means instead of two separate transmission means for the purpose of facilitating the dissemination of such

programming among remote locations. Also note, the Carrubba et al. reference discloses simultaneously supplying different data to a plurality of users (Carrubba et al. 4:33-37) and The Maeng reference discloses a sender transmitting video. However, the Carrubba et al. and Maeng combination does not specifically teach a plurality of programming transmission sources. Nevertheless, the examiner gives Official Notice that it is notoriously well known in the art to employ a plurality of programming transmission sources for the purpose of providing a plurality of programs to viewers in order to provide users with a number of choices to select from and to increase the likelihood that at least on program being offered will meet the users interest thus increasing viewer ship and business for the provider. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art to further modify the Carrubba et al. and Maeng combination accordingly for the above stated advantages.

10. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carrubba et al. (US 5,629,866) in further view of Maeng (US 6,476,873 B1) and Hjelsvold et al. (US 2003/01475333 A1).

As to claim 22, note the Carrubba et al. reference discloses providing purchasable enhancements to an audio-visual program wherein "[w]ith the video-on-demand service, video film data are supplied to CD-I players on request. The databank may be controlled by a provider who provides the basic part free of charge or at a small amount on CD-I disc to the users, and allows users to read the second part from the databank against payment of a higher amount. In other words, the Carrubba et al. reference discloses transmission of the basic part and enhanced part of the audio-visual transmission separately. However, the Carrubba et al. reference is silent as to modifying the transmission of the programming transmission to the client system with the

upgraded media feature. Now note, the Maeng reference that discloses the enhancement of a selectable region of video. The claimed "modifies transmission of the programming transmission to the client system with the upgraded media feature" is met by the Maeng user designation of the type of video information desired for display and designation of a portion of the display for enhancement wherein control information is sent to the sender which in turn provides the requested information (Maeng 6:40-67; 7:1-4) where the sender and receiver are coupled via a communications line (Maeng 4:55-67). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Carrubba et al. purchasable enhancements with the Maeng transmission of video and enhanced video over the same communication medium for the purpose of providing a basic part and enhanced part of an audio visual program over one transmission means instead of two separate transmission means for the purpose of facilitating the dissemination of such programming among remote locations. Also note, the Carrubba et al. reference discloses simultaneously supplying different data to a plurality of users (Carrubba et al. 4:33-37) and The Maeng reference discloses a sender transmitting video. However, the Carrubba et al. and Maeng combination does not specifically teach a plurality of programming transmission sources. Nevertheless, the examiner gives Official Notice that it is notoriously well known in the art to employ a plurality of programming transmission sources for the purpose of providing a plurality of programs to viewers in order to provide users with a number of choices to select from and to increase the likelihood that at least on program being offered will meet the users interest thus increasing viewer ship and business for the provider. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art to further modify the Carrubba et al.

and Maeng combination accordingly for the above stated advantages. Further note, the Carrubba et al. reference discloses providing enhancements to a user upon payment of a fee. However, the Carrubba et al. reference is silent as to how the payment is performed. Now note, the Hjelsvold et al. reference that discloses a system for hypervideo filtering based on end-user payment interest and capability. The claimed "billing processor to coordinate the purchase of the programming transmission with the upgraded media feature" is met by "[f]or payment, wallet 25, commerce server 26, and Secure Electronic Transaction (SET) server 27 are responsible for initiating a payment transaction and exchanging payment information with payment gateway 28 of clearing house 29" (Hjelsvold [0042]) wherein if payment is accepted then the system proceeds to distribution of the paid for level of programming (Hjelsvold [0055]). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made of further modify the Carrubba et al. purchasable audio-visual enhancements with the Hjelsvold et al. computerized payment for the purpose of providing a means of billing users for enhancements as well as providing an automated process wherein a user may quickly obtain authorization to receive enhancements.

11. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carrubba et al. (US 5,629,866) in further view of Hendricks et al. (US 5,990,927).

As to claim 24, note the Carrubba et al. reference discloses an entertainment system (figure 1) to display the programming transmission with the upgraded media feature (columns 102). However, the Carrubba et al. reference is silent as to a user interface to provide a plurality of selection options to a user, wherein said user interface receives the selection from the user as recited in the claim. Now note the Hendricks et al, reference, that discloses a communication

system comprising a user interface to provide a plurality of selection options to a user and wherein the user interface receives the selection from the user for the advantage of providing the user with a menu of options to make desired program selections (Hendricks et al., columns 12-13, figures 1-15 and 21-23). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Carrubba et al. system (if necessary) to include a user interface to provide a plurality of selection options to a user and wherein the user interface receives the selection from the user, as taught by Hendricks et al., for the purpose/advantage of providing the user with a menu of options to facilitate the making of desired program selections.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The Nagashima et al. reference (US 2001/0029608 A1) discloses an image transmission apparatus, image transmission system, and communication apparatus.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnny Ma whose telephone number is (703) 305-8099. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (703) 305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jm

JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600